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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,607

01/28/2005

Eiji Terada

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
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ALEXANDRIA, VA 22314

EXAMINER

HOLLOMAN, NANNETTE

ART UNIT

PAPER NUMBER

1612

NOTIFICATION DATE

DELIVERY MODE

12/09/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/522,607	<b>Applicant(s)</b> TERADA, EIJI	
	<b>Examiner</b> NANNETTE HOLLOMAN	<b>Art Unit</b> 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office Action is in response to the Request for Continued Examination filed on October 15, 2010. Applicants' arguments, filed October 15, 2010, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

#### ***Claim Rejections - 35 USC § 103***

Claims 1-5 and 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kasuga et al. (EP 1013754) in view of Silicone innovation for hair care (Global cosmetic Industry, 01 May 02, Modified amino polysiloxanes). This rejection is maintained. Claims 1-5 have been cancelled.

#### **Applicant's Arguments**

Applicant argues Kasuga et al. do not suggest a hair detergent composition comprising the claimed components (a)-(b) in combination with the claimed silicone (c). Applicant further argues a skilled artisan would not have modified the detergent of Kasuga et al. with the presently claimed silicon with a reasonable expectation of

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providing rich foaming upon shampooing and an excellent conditioning effect to the hair.

Applicant also argues the claimed hair detergent provides unexpected results.

Applicant's arguments have been fully considered but they are not persuasive.

### **Examiner's Response**

In regard to selecting the claimed components, Kasuga et al. disclose a composition comprising (a) a surfactant, i.e. anionic, (b) a monoglyceryl ether having a linear or branched alkyl or alkenyl group having 4 to 12 carbon atoms and (c) a silicone compound (Abstract), therefore one would not need to select the components that are disclosed as the composition. The Silicone innovation for hair care article was used to disclose that DC 8500 Conditioning Agent provides superior conditioning in hair shampoos and increase color intensity, retention and shine, while increasing stability of the composition (emphasis added), therefore providing the motivation to one of ordinary skill to use DC 8500 as the silicone of Kasuga et al.

In regard to Applicant's alleged unexpected results, Applicant contends when KT 1989 amino-silicon; which is not within the claimed silicones, is used, the hair detergent has inferior foaming performance, softness, and smoothness of the dry and wet hair. When looking to the Kasuga et al. (p. 5, Table 1), the reference compares products using similar criteria of the instant specification; volume of foam, foam quality and feel to the hair with a similar ranking scale of results from 10 expert panelists. Kasuga's invention product 3 gave very good foaming, foams were creamy and very smooth and the hair felt very good without creakiness and with smoothness. Further in regard to the

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foaming, the results A and B could differ by 0.1 and therefore may be interpreted as the same based on error. Therefore, Applicant's claim that the hair detergent comprising the 8500 conditioning agent provides an unexpectedly rich foaming upon shampooing and gives an excellent conditioning effect to the hair does not appear to be supported, since the reference product gave similar results. Furthermore, DC 8500 has been reported to have superior conditioning and as shown by Goliath has increased compatibility and stability over other amino silicones that interact with anionic surfactants in shampoos. Therefore, one would expect the formulation comprising DC 8500 to have increased physical properties, i.e. better foaming so the results do not appear to be unexpected.

Even, assuming, purely *arguendo*, that unexpected results had been shown, Applicant's claims encompass more compounds, i.e. anionic surfactant, monoalkyl glyceryl ether and silicon compounds; and varying concentrations of these compounds, i.e. the anionic surfactant having a concentration ranging from 0.5% to 60 wt.%, monoalkyl glyceryl ether ranging from 0.1% to 30 wt.% and silicon compounds ranging from 0.05% to 4 wt.%, than that disclosed by Table 1 in the specification. Therefore the examples are not commensurate in scope with the instant claims.

### **Conclusion**

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./  
Examiner, Art Unit 1612

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612